

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATUO ASAMI and HITOSHI YOZAWA

Appeal No. 1996-3578
Application No. 08/125,756¹

ON BRIEF

Before HAIRSTON, JERRY SMITH, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 17-26, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed Sep. 24, 1993. According to appellants, this application is a continuation of serial number 07/755,210, filed Sep. 05, 1991, now U.S. Patent 5,309,242, issued May 3, 1994.

BACKGROUND

The appellants' invention relates to a film image input system having an automatic scan speed/scope adjustment. An understanding of the invention can be derived from a reading of exemplary claim 17, which is reproduced below.

17. A film image input system wherein an image of a developed still photo film is focused on an image sensing plane of an area sensor through a taking lens to be converted into electric signals and said electric signals are input into a video monitor, to thereby reproduce the image on a screen of the video monitor, comprising:

a zoom mechanism for changing an image magnification of the taking lens;

a scan mechanism for moving an image taking position of the taking lens within a frame on the film; and

control means for controlling the scan mechanism in such a manner that a moving speed of the image taking position of the scan mechanism on the film is automatically decreased as the image magnification of the taking lens is increased, in order to move the image on the screen, during scanning, at a desired speed in accordance with the image magnification.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:²

DiPietro et al. (DiPietro)	4,616,926	Oct. 14, 1986
Isogai et al. (Isogai)	4,639,787	Jan. 27, 1987

² The references Ramsay et al., Fearnside and Brownstein, mentioned in the Examiner's answer were not applied or discussed further and will not be considered in this appeal.

Claims 17-26 stand rejected under 35 U.S.C. § 102 as being unpatentable over Isogai. Claims 17-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over DiPietro.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No.17 , mailed Sep. 19, 1995) and supplemental answer (Paper No.19 , mailed Dec. 12, 1995) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 16, filed Jun. 22, 1995) and reply brief (Paper No. 17 1/2, filed Nov. 20, 1995) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

§ 102 Rejection

Appellants argue that Isogai is "silent as to correlating scanning speed and magnification." (See brief at page 4.) (Emphasis in original.) We agree with appellants. Isogai does not teach the automatic decreasing of the moving speed as the magnification of the taking lens is increased. Isogai merely teaches the use of a high

speed with pre-scanning and a regular scanning speed. (See Isogai at col. 3, lines 66-68.) In the portion of Isogai set forth by the examiner, we find no discussion of the relationship as set forth in claim 17. Furthermore, we find no discussion of the scan scope or the automatic control thereof as set forth in the language of claim 18 in the portion of Isogai cited by the examiner.

With respect to the claim limitation of automatically changing the speed of the scan in claim 17, the examiner discusses “trimming an image.” (See Final rejection at page 2.) The examiner has not identified how this trimming relates to automatic change in the speed of the scan. In the answer, the examiner states the “image sensor 15 can be moved at a variable speed such as high or low speeds in relationship with the magnification of the zoom lens 11, . . . col. 4, line 22+ and col. 5).” (See answer at page 4.) (Emphasis added.) Appellants argue that this portion of Isogai does not teach a relationship between the speed and magnification. (See brief at page 5.) Appellants address that portion of the text of the reference. Id. at 5-6. We agree with appellants that Isogai does not teach the claimed relationship between the speed and magnification. Assuming *arguendo* that the system of Isogai could be controlled as the Examiner states, we are still left with the fact that the reference does not explicitly or inherently teach this limitation of the claimed invention. Therefore, the Examiner has not set forth a ***prima facie*** case of anticipation.

With respect to the claim limitation of automatically changing the scope of the scan in claim 18, the Examiner states that “although, Isogai et al do not particularly teach the correlation of magnification and scope, which is performed automatically, Isogai et al teach the correlation is done manually, and ‘automatically’ is not given any patentable weight since it does not distinguish the claimed structure over the prior art. “ (See Final rejection at page 2.) Appellants argue that this statement by the Examiner is in error. (See brief at page 7.) We agree with appellants. “For the reference to anticipate the invention, all of the claim limitations must be met.” **In re Alul** 468 F.2d 939, 943, 175 USPQ 700, 703 (CCPA 1972). Clearly, the Isogai reference does not teach all of the claim limitations.

Therefore, we will not sustain the lack of novelty rejection of claims 17, 18 and their dependent claims 19-24. Claims 25 and 26 contain the corresponding claim limitations concerning the scan speed and scan scope, therefore we will not sustain the lack of novelty rejection of claims 25 and 26.

§ 103 Rejection

The Examiner sets forth the rejection under 35 U.S.C. § 103 with unsupported statements as to how the skilled user of the system of DiPietro would have operated the system with a magnified image and the control of the speed of the scan in some unstated

manner since “it is very difficult to control the film image if the magnification speed and scanning speed are increasing at the same time.” (See answer at page 6.) The Examiner then concludes that the skilled artisan would have been motivated to decrease the speed of the scan with increasing magnification. Id. The Examiner then concludes that the operator control through the control ball 58 would be replaced by an automatic control. (See answer at pages 6-7.) Clearly, the Examiner is reconstructing appellants’ invention from appellants’ own disclosure rather than from a line of reasoning separate from appellants’ disclosure. We will not sustain the rejection of claim 17 based upon the evidence set forth by the Examiner.

With respect to claim 18, the Examiner sets forth that the automatic control of scan scope is “inherently included in the process of moving the film image by the scan ball.” (See answer at page 7.) We do not agree with the Examiner. The Examiner argues that DiPietro teaches that “a speed of a film . . . can be kept constant by

controlling scanning [ball] 58 and zoom button 54” and that a “negative linear relation . . . can be kept in a [sic] inversely proportional manner by controlling the scanning ball 58 and zoom button 54” (See answer at page 8.) (Emphasis added.) Appellants argue that the

Examiner is merely arguing that the system of DiPietro is “capable” of performing the claimed functions, and that the Examiner has failed to provide motivation to modify the reference to perform the claimed functions. (See reply brief at page 6.) We agree with appellants. “The question is . . . whether it [the modification] would have been obvious from a fair reading of the prior art reference as a whole . . . The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. “ **In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We agree with appellants that the Examiner has not set forth an adequate line of reasoning concerning the motivation to modify the teachings of DiPietro. Therefore, we will not sustain the rejection of claim 18.

Therefore, we will not sustain the obviousness rejection of claims 17, 18 and their dependent claims 19-24. Claims 25 and 26 contain the corresponding claim limitations concerning the scan speed and scan scope, therefore we will not sustain the obviousness rejection of claims 25 and 26.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 17-26 under 35 U.S.C. § 102 and 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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